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April 15, 2005
Date

Melanie S. Jernberg
Melanie S. Jernberg

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Art Unit : 2859
Examiner : M. Jagan
Applicant : Joseph D. Revnell
Appln. No. : 09/505,119
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For : MEASURING AND LAYOUT DEVICE

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Commissioner for Patents
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APPELLANT'S REQUEST FOR RECONSIDERATION (37 CFR §41.52)

This brief is in furtherance of the Decision of the Board and Patent Appeals and Interferences issued on February 18, 2005.

This request for reconsideration contains these items under the following headings, and in the order set forth below:

- I. Status of Claims
- II. The Board's Decision
- III. Issues
- IV. Arguments
- V. Conclusion

The final page of this brief bears the attorney's signature.

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I. Status of Claims

Claims 2-18 and 25-69 are pending in this application. Claims 26-29 and 68 are allowed. The Examiner's rejection of claims 8, 16-18, 33, 39-53, 57, 59 and 67 was reversed such that claims 16-18 are now allowed and claims 8, 33, 39-53, 57, 59 and 67 (which are all dependent claims) are in condition for allowance. Claims 2-7, 9-15, 25, 30-32, 34-38, 54-56, 58, 60-67 and 69 are the subject of this request for reconsideration.

II. The Board's Decision

Rejections Not Sustained

The rejection of claims 25, 54-56, 58, 59, 61, 62 and 64 as being rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,344,231 to Martinez was not sustained.

The rejection of claims 17, 40, 42-48, 53, 60 and 63 as being rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 4,344,231 to Martinez was not sustained.

The rejection of claims 51 and 66 as being rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 4,344,231 to Martinez in view of French Patent 2,614,982 to Mercier was not sustained.

The rejection of claim 57 as being rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 3,269,015 to Barker in view of U.S. Patent No. 2,349,670 to Moxey and U.S. Patent No. 4,835,870 to Rauch et al. was not sustained.

The rejection of claims 8 and 59 as being rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 3,269,015 to Barker in view of U.S. Patent No. 2,349,670 to Moxey and U.S. Patent No. 4,344,231 to Martinez was not sustained.

The rejection of claims 16 and 67 as being rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 3,269,015 to Barker in view of U.S. Patent No. 2,349,670 to Moxey and U.S. Patent No. 6,115,931 to Arcand was not sustained.

The rejection of claim 33 as being rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 3,269,015 to Barker in view of U.S. Patent No. 2,349,670 to Moxey,

U.S. Patent No. 5,768,797 to Trevino and U.S. Patent No. 4,344,231 to Martinez was not sustained.

The rejection of claim 39 as being rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 3,269,015 to Barker in view of U.S. Patent No. 2,349,670 to Moxey, U.S. Patent No. 5,768,797 to Trevino and U.S. Patent No. 6,115,931 to Arcand was not sustained.

The rejection of claims 17, 40, 43, 45, 47, 48 and 50 as being rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 3,269,015 to Barker was not sustained.

The rejection of claims 18 and 52 as being rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 3,269,015 to Barker in view of U.S. Patent No. 6,115,931 to Arcand was not sustained.

The rejection of claim 41 was rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 3,269,015 to Barker in view of U.S. Patent No. 4,835,870 to Rauch et al. was not sustained.

The rejection of claims 44 and 46 as being rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 3,269,015 to Barker in view of U.S. Patent No. 4,344,231 to Martinez was not sustained.

The rejection of claim 49 as being rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 3,269,015 to Barker in view of U.S. Patent No. 5,768,797 to Trevino was not sustained.

The rejection of claim 51 as being rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 3,269,015 to Barker in view French Patent 2,614,982 to Mercier was not sustained.

Rejections Sustained

The rejection of claim 69 as being rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,344,231 to Martinez was sustained.

Rejections Sustained with New Ground of Rejection

The rejection of claims 2-4, 7, 9, 11, 12, 14, 25, 54-56, 58, 60, 62, 63 and 65 as being rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 3,269,015 to Barker in view of U.S. Patent No. 2,349,670 to Moxey was sustained.

The rejection of claim 5 as being rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 3,269,015 to Barker in view of U.S. Patent No. 2,349,670 to Moxey and U.S. Patent No. 4,835,870 to Rauch et al. was sustained.

The rejection of claims 6, 13, 30, 32, 34, 36-38 and 64 as being rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 3,269,015 to Barker in view of U.S. Patent No. 2,349,670 to Moxey and U.S. Patent No. 5,768,797 to Trevino was sustained.

The rejection of claims 10 and 61 as being rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 3,269,015 to Barker in view of U.S. Patent No. 2,349,670 to Moxey and U.S. Patent No. 4,344,231 to Martinez was sustained.

The rejection of claims 15 and 66 as being rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 3,269,015 to Barker in view of U.S. Patent No. 2,349,670 to Moxey and French Patent 2,614,982 to Mercier was sustained.

The rejection of claim 31 as being rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 3,269,015 to Barker in view of U.S. Patent No. 2,349,670 to Moxey, U.S. Patent No. 5,768,797 to Trevino and U.S. Patent No. 4,835,870 to Rauch et al. was sustained.

The rejection of claim 35 as being rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 3,269,015 to Barker in view of U.S. Patent No. 2,349,670 to Moxey, U.S. Patent No. 5,768,797 to Trevino and U.S. Patent No. 4,344,231 to Martinez was sustained.

III. Issues

The issues are:

Issue 1: Whether claim 69 is anticipated by U.S. Patent No. 4,344,231 to Martinez?

Issue 2: Whether claims 2-4, 7, 9, 11, 12, 14, 25, 54-56, 58, 60, 62, 63 and 65 are unpatentable over U.S. Patent No. 3,269,015 to Barker (or the Barker '015 patent in view of U.S. Patent No. 2,349,670 to Moxey)?

Issue 3: Whether claim 5 is unpatentable over U.S. Patent No. 3,269,015 to Barker (or the Barker '015 patent in view of U.S. Patent No. 2,349,670 to Moxey and/or U.S. Patent No. 4,835,870 to Rauch et al.)?

Issue 4: Whether claims 6, 13, 30, 32, 34, 36-38 and 64 are unpatentable over U.S. Patent No. 3,269,015 to Barker (or the Barker '015 patent in view of U.S. Patent No. 2,349,670 to Moxey and/or U.S. Patent No. 5,768,797 to Trevino)?

Issue 5: Whether claims 10 and 61 are unpatentable over U.S. Patent No. 3,269,015 to Barker (or the Barker '015 patent in view of U.S. Patent No. 2,349,670 to Moxey and/or U.S. Patent No. 4,344,231 to Martinez)?

Issue 6: Whether claims 15 and 66 are unpatentable over U.S. Patent No. 3,269,015 to Barker (or the Barker '015 patent in view of U.S. Patent No. 2,349,670 to Moxey and/or French Patent 2,614,982 to Mercier)?

Issue 7: Whether claim 31 is unpatentable over U.S. Patent No. 3,269,015 to Barker (or the Barker '015 patent in view of U.S. Patent No. 2,349,670 to Moxey, U.S. Patent No. 5,768,797 to Trevino and/or U.S. Patent No. 4,835,870 to Rauch et al.)?

Issue 8: Whether claim 35 is unpatentable over U.S. Patent No. 3,269,015 to Barker (or the Barker '015 patent in view of U.S. Patent No. 2,349,670 to Moxey, U.S. Patent No. 5,768,797 to Trevino and/or U.S. Patent No. 4,344,231 to Martinez)?

IV. Arguments

Issue 1: Whether claim 69 is anticipated by U.S. Patent No. 4,344,231 to Martinez?

Argument: In order to anticipate the invention as claimed, all elements must be found in a single reference. *Studiengesellschaft Kohle v. Dart Indus.*, 762 F.2d 724 (Fed. Cir. 1984).

Discussion:

Claim 69 defines a method of measuring and laying out an area including, among other things, providing a stationary member, rotatably coupling an angle and distance device to the stationary member, with the angle and distance device including a longitudinally and laterally rigid extendable tape that can be extended from a central point, and forming an accurate template as the angle and distance device is rotated and the tape is extended and retracted to a plurality of critical features of the area, wherein the step of forming an accurate template includes recording a distance of the tape from the stationary member to each of the plurality of critical features and recording angle information for each distance recording signifying an angle of the tape relative to the stationary member during each distance recording and wherein the stationary member remains stationary during at least two distance and angle information recordings.

The prior art of record does not disclose or suggest the above noted features of claim 69. Specifically, the Martinez '231 patent does not disclose recording a distance of the tape from the stationary member to each of a plurality of critical features and recording angle information for each distance recording signifying an angle of the tape relative to the stationary member during each distance recording.

The Martinez '231 patent discloses that the area mapping apparatus is used in the following manner:

The user places the board 12 on green 4 in a suitable location. . . An assistant then pays out tape 34 from tape reel 36 until the edge 46 of green 4 is reached. Pulling measuring instrument somewhat taut, to assure an accurate reading in distance and rotary position, the assistant reads off the distance from measuring scale 42 on tape 34 where the tape crosses the edge 46 of the green. This point is indicated in FIG. 1 by an "x" 48. This distance is transferred to sheet 44 at the corresponding point on proportional scale 30 by the user. Measuring instrument is then indexed about pivot peg 14 an appropriate distance and a new measurement is called out by the assistant to the user. This process is repeated as often as necessary to achieve the desired degree of resolution.

Lines 57-58 and 76-68 of column 2 and lines 1-13 of column 3. While the Martinez '231 patent discloses reading off the distance from the measuring scale 42 on the tape 34 and transferring the distance to the sheet 44 at the corresponding point on the proportional scale 30, the Martinez '231 patent does not disclose recording angle information for each distance recording signifying an angle of the tape relative to the stationary member during each distance recording.

According to the Board, "[c]laim 69 does not, as urged by the appellant, require two recording acts: one for distance and one for angle." Applicant respectfully disagrees. Claim 69 states that "the step of forming the template includes ... recording angle information for each distance recording." Therefore, as a condition precedent to recording angle information, there must be a "distance recording." The recordation of angle information is not for each distance, it is for each distance recording. Therefore, claim 69 does require two recording acts: one for distance and one for angle. Therefore, since the Martinez '231 patent does not disclose recording both a distance and angle information, claim 69 is in condition for allowance.

Accordingly, claim 69 is allowable over the Martinez '231 patent, and the Board is requested to reverse the rejection of these claims.

Issue 2: Whether claims 2-4, 7, 9, 11, 12, 14, 25, 54-56, 58, 60, 62, 63 and 65 are unpatentable over U.S. Patent No. 3,269,015 to Barker (or the Barker '015 patent in view of U.S. Patent No. 2,349,670 to Moxey)?

Argument:

In order to anticipate the invention as claimed, all elements must be found in a single reference. *Studiengesellschaft Kohle v. Dart Indus.*, 762 F.2d 724 (Fed. Cir. 1984).

Additionally, in order to establish a *prima facie* case of obviousness, three criteria must be met. M.P.E.P. §706.02(j). Firstly, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Fine*, 5 U.S.P.Q.2d 1586 (Fed. Cir. 1988). Secondly, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Thirdly, the prior art reference (or references)

must teach or suggest all the claim limitations. *In re Royka*, 180 U.S.P.Q. 550 (C.C.P.A. 1974). The burden is on the Examiner to create a prima facie case of obviousness, not on the Applicant to provide reasons for patentability. See *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Applicant submits that neither the Board nor the Examiner has created a prima facie case of anticipation or obviousness to reject claims 2-4, 7, 9, 11, 12, 14, 25, 54-56, 58, 60, 62, 63 and 65 over the Barker '015 patent alone or in view of the Moxey '670 patent.

Discussion:

Claims 2-4, 7, 9, 11, 12, 14, 25, 54-56, 58, 60, 62, 63 and 65 were rejected by the Examiner under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 3,269,015 to Barker in view of U.S. Patent No. 2,349,670 to Moxey. The Board sustained the Examiner's rejection by stating that:

Barker alone meets the argued limitations in independent claims 9, 12 and 25. We shall therefore sustain the standing 35 U.S.C. §103(a) rejection of claims 9, 12 and 25, and dependent claims 2 through 4, 7, 11, 14, 54 through 56, 58, 60, 62, 63 and 65, as being unpatentable over Barker in view of Moxey.

Accordingly, although the Board has rejected claims 2-4, 7, 9, 11, 12, 14, 25, 54-56, 58, 60, 62, 63 and 65 "as being unpatentable over Barker in view of Moxey," it appears the Board has really rejected all of the above noted claims as being anticipated by the Barker '015 patent under 35 U.S.C. §102(b). Therefore, Applicant's arguments below are addressed to both the deficiencies in a rejection of the above noted claims over the Barker '015 patent alone and in combination with the Moxey '670 patent.

Claim 9

Claim 9 defines a measuring and layout device including, among other things, a stationary member and an angle and distance device fixedly and rotatably attached to the stationary member, the angle and distance device including a longitudinally and laterally rigid extendible tape that can be extended from a central point and an edge that facilitates reliably

marking on the stationary member to form an accurate template as the angle and distance device is rotated and the tape is extended and retracted to critical features of an area, wherein the template is formed by markings written directly onto the stationary member.

The Barker '015 patent does not anticipate claim 9 as the Barker '015 patent does not include all of the claimed features of claim 9. According to the Board, "Barker's lower arm 10 effectively constitutes a stationary member." However, the Barker '015 patent does not disclose any writings on the lower arm 10. Therefore, the Barker '015 patent does not include a template formed by markings written directly onto the stationary member. Accordingly, the Barker '015 patent does not include all of the features of claim 9.

Furthermore, any combination of the Barker '015 patent and the Moxey '670 patent would not include all of the claimed features of claim 9. Specifically, neither the Barker '015 patent nor the Moxey '670 patent disclose an angle and distance device fixedly and rotatably attached to a stationary member. According to the final Office Action, the Moxey '670 patent discloses a layout device that "utilizes means (33) to fasten the device to the stationary member" and "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the angle and distance device disclosed by Barker by adding means for fixedly and rotatably attaching the device to the stationary member, as disclosed by Moxey, in order to fasten the device to the stationary member and thereby obtain a more accurate layout." Office Action mailed January 22, 2003, paragraph 10. However, the Moxey '670 patent does not disclose "means for fixedly and rotatably attaching the device to the stationary member." The Moxey '670 patent discloses a housing 10 having an "embossment 30, which is slotted vertically at two opposite sides, as indicated at 31, to constitute a chuck for a pivot pin 33." Lines 44-48 of column 1 of page 2. During use, the pivot pin 33 is "seated in the surface at the desired point." Lines 2-4 of column 1 of page 3. However, seating the pivot pin 33 in the surface as disclosed by the Moxey '670 patent does not fixedly and rotatably attach the housing 10 to the surface. Therefore, any combination of the Barker '015 patent and the Moxey '670 patent would not result in an angle and distance device fixedly

and rotatably attached to a stationary member. Accordingly, claim 9 is in condition for allowance.

Claim 11

Claim 11 depends from claim 9, and further defines the stationary member as having a circular configuration. First, since claim 9 defines unobvious patentable subject matter, claim 11 defines unobvious patentable subject matter. Second, the Barker '015 patent does not include a stationary member as having a circular configuration. The leg 10 is not circular. Moreover, there is no suggestion or motivation for making the lower leg 10 circular as any such modification would result in a lower leg 10 being smaller than the upper leg 11, thereby not allowing the upper leg 11 full rotation, or would result in a lower leg 10 being bigger than the upper leg 11 and circular, which would not allow full use of the retractable rule 29 and associated functions on the upper leg 11. Accordingly, claim 11 is not anticipated or suggested by the Barker '015 patent. As to any combination of the Barker '015 patent and the Moxey '670 patent to rejection claim 11, this combination has the same deficiencies noted above with regard to claim 9. Accordingly, claim 11 is in condition for allowance.

Claim 12

Claim 12 defines a measuring and layout device including, among other things, a stationary member and an angle and distance device fixedly and rotatably attached to the stationary member, the angle and distance device including a longitudinally and laterally rigid extendible tape that can be extended from a central point and an edge that facilitates reliably marking on the stationary member to form an accurate template, wherein the stationary member has a substantially semi-circular configuration.

The Barker '015 patent does not anticipate claim 12 as the Barker '015 patent does not include all of the claimed features of claim 12. According to the Board, "Barker's lower arm 10 effectively constitutes a stationary member." However, the Barker '015 patent does not disclose that the lower arm 10 has a substantially semi-circular configuration. Moreover, there

is no suggestion or motivation for making the lower leg 10 semi-circular as any such modification would result in a lower leg 10 being smaller than the upper leg 11, thereby not allowing the upper leg 11 full rotation, or would result in a lower leg 10 being bigger than the upper leg 11 and semi-circular, which would not allow full use of the retractable rule 29 and associated functions on the upper leg 11. Accordingly, the Barker '015 patent does not include all of the features of claim 12.

Furthermore, any combination of the Barker '015 patent and the Moxey '670 patent does not include all of the claimed features of claim 12. In regard to the third criterion of obviousness, the prior art of record does not disclose or suggest the claim limitations of claim 12. As stated above regarding claim 9, any combination of the Barker '015 patent and the Moxey '670 patent would not result in an angle and distance device fixedly and rotatably attached to a stationary member. Accordingly, claim 12 is in condition for allowance.

Claims 2-4, 7 and 14

Claims 2-4, 7 and 14 depend from claim 12, and since claim 12 defines unobvious patentable subject matter, claims 2-4, 7 and 14 define unobvious patentable subject matter. Accordingly, claims 2-4, 7 and 14 are in condition for allowance.

Claim 25

Claim 25 defines a method of measuring and laying out an area including, among other things, providing a stationary member having a flat surface adapted to be marked on, fixedly and rotatably attaching an angle and distance device to the stationary member, the angle and distance device including a longitudinally and laterally rigid extendible tape, and forming an accurate template by reliably marking on the stationary member as the angle and distance device is rotated and the tape is extended and retracted to critical features of the area.

The Barker '015 patent does not anticipate claim 25 as the Barker '015 patent does not include all of the claimed features of claim 25. According to the Board, "Barker's lower arm 10 effectively constitutes a stationary member." However, the Barker '015 patent does not

disclose “forming an accurate template by reliably marking on the stationary member as the angle and distance device is rotated.” The Barker ‘015 patent does not expressly or inherently disclose marking on the lower arm 10. Therefore, the Barker ‘015 patent does not disclose the method of claim 25.

Furthermore, any combination of the Barker ‘015 patent and the Moxey ‘670 patent does not include all of the claimed features of claim 25. In regard to the third criterion of obviousness, the prior art of record does not disclose or suggest the claim limitations of claim 25.

As stated above regarding claim 9, any combination of the Barker ‘015 patent and the Moxey ‘670 patent would not result in an angle and distance device fixedly and rotatably attached to a stationary member. Accordingly, claim 25 is in condition for allowance.

Claims 54-56, 58 and 65

Claims 54-56, 58 and 65 depend from claim 25, and since claim 25 defines unobvious patentable subject matter, claims 54-56, 58 and 65 define unobvious patentable subject matter. Accordingly, claims 54-56, 58 and 65 are in condition for allowance.

Claim 60

Claim 60 depends from claim 25 and further defines the method and measuring and laying out to state that the step of forming the accurate template includes writing directly onto the stationary member. First, since claim 25 defines unobvious patentable subject matter, claim 60 defines unobvious patentable subject matter. Second, as stated above, the Barker ‘015 patent does not disclose marking directly on the lower arm 10. Therefore, the Barker ‘015 patent does not include all of the steps of claim 60. As to any combination of the Barker ‘015 patent and the Moxey ‘670 patent to rejection claim 60, this combination has the same deficiencies noted above with regard to claim 25. Accordingly, claim 60 is in condition for allowance.

Claim 62

Claim 62 depends from claim 25, and further defines the stationary member as having a circular configuration. First, since claim 25 defines unobvious patentable subject matter, claim 62 defines unobvious patentable subject matter. Second, the Barker '015 patent does not include a stationary member as having a circular configuration. The leg 10 is not circular. Moreover, there is no suggestion or motivation for making the lower leg 10 circular as any such modification would result in a lower leg 10 being smaller than the upper leg 11, thereby not allowing the upper leg 11 full rotation, or would result in a lower leg 10 being bigger than the upper leg 11 and circular, which would not allow full use of the retractable rule 29 and associated functions on the upper leg 11. Accordingly, claim 62 is not anticipated or suggested by the Barker '015 patent. As to any combination of the Barker '015 patent and the Moxey '670 patent to rejection claim 62, this combination has the same deficiencies noted above with regard to claim 25. Accordingly, claim 62 is in condition for allowance.

Claim 63

Claim 63 depends from claim 25, and further defines the stationary member as having a semi-circular configuration. First, since claim 25 defines unobvious patentable subject matter, claim 63 defines unobvious patentable subject matter. Second, the Barker '015 patent does not include a stationary member as having a semi-circular configuration. The leg 10 is not semi-circular. Moreover, there is no suggestion or motivation for making the lower leg 10 semi-circular as any such modification would result in a lower leg 10 being smaller than the upper leg 11, thereby not allowing the upper leg 11 full rotation, or would result in a lower leg 10 being bigger than the upper leg 11 and semi-circular, which would not allow full use of the retractable rule 29 and associated functions on the upper leg 11. Accordingly, the Barker '015 patent does not include all of the features of claim 63. Therefore, claim 63 is not anticipated or suggested by the Barker '015 patent. As to any combination of the Barker '015 patent and the Moxey '670 patent to rejection claim 63, this combination has the same deficiencies noted above with regard to claim 25. Accordingly, claim 63 is in condition for allowance.

Conclusion

Claims 2-4, 7, 9, 11, 12, 14, 25, 54-56, 58, 60, 62, 63 and 65 are allowable over the Barker '015 patent either alone or in view of the Moxey '670 patent, and the Board is requested to reverse the rejection of these claims.

Issue 3: Whether claim 5 is unpatentable over U.S. Patent No. 3,269,015 to Barker (or the Barker '015 patent in view of U.S. Patent No. 2,349,670 to Moxey and/or U.S. Patent No. 4,835,870 to Rauch et al)?

Argument:

In order to anticipate the invention as claimed, all elements must be found in a single reference. *Studiengesellschaft Kohle v. Dart Indus.*, 762 F.2d 724 (Fed. Cir. 1984).

Additionally, in order to establish a *prima facie* case of obviousness, three criteria must be met. M.P.E.P. §706.02(j). Firstly, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Fine*, 5 U.S.P.Q.2d 1586 (Fed. Cir. 1988). Secondly, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Thirdly, the prior art reference (or references) must teach or suggest all the claim limitations. *In re Royka*, 180 U.S.P.Q. 550 (C.C.P.A. 1974). The burden is on the Examiner to create a *prima facie* case of obviousness, not on the Applicant to provide reasons for patentability. See *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Applicant submits that neither the Board nor the Examiner has created a *prima facie* case of anticipation or obviousness to reject claim 5 over the Barker '015 patent alone or in view of the Moxey '670 patent and/or the Rauch et al. '870 patent.

Discussion:

Claim 5 defines the measuring and layout device as including a carrier having a front leg adjacent a top of the stationary member, with the front leg having guides for the tape and a straight edge for making the template. First, claim 5 depends from claim 12, and since claim 12

defines patentable subject matter as discussed above, claim 5 defines patent subject matter. Second, the Barker '015 patent does not include a front leg having guides for the tape and a straight edge for making the template. Neither the leg 10 nor the leg 11 of the Barker '015 patent comprises a leg having guides for tape. As to any combination of the Barker '015 patent and the Moxey '670 patent to rejection claim 5, this combination has the same deficiencies noted above with regard to claim 12. Accordingly, claim 5 is in condition for allowance.

Accordingly, claim 5 is allowable over the Barker '015 patent alone or in view of the Moxey '670 patent and/or the Rauch et al. '870 patent, and the Board is requested to reverse the rejection of this claim.

Issue 4: Whether claims 6, 13, 30, 32, 34, 36-38 and 64 are unpatentable over U.S. Patent No. 3,269,015 to Barker (or the Barker '015 patent in view of U.S. Patent No. 2,349,670 to Moxey and/or U.S. Patent No. 5,768,797 to Trevino)?

Argument:

In order to anticipate the invention as claimed, all elements must be found in a single reference. *Studiengesellschaft Kohle v. Dart Indus.*, 762 F.2d 724 (Fed. Cir. 1984).

Additionally, in order to establish a *prima facie* case of obviousness, three criteria must be met. M.P.E.P. §706.02(j). Firstly, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Fine*, 5 U.S.P.Q.2d 1586 (Fed. Cir. 1988). Secondly, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Thirdly, the prior art reference (or references) must teach or suggest all the claim limitations. *In re Royka*, 180 U.S.P.Q. 550 (C.C.P.A. 1974). The burden is on the Examiner to create a *prima facie* case of obviousness, not on the Applicant to provide reasons for patentability. See *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Applicant submits that neither the Board nor the Examiner has created a prima facie case of anticipation or obviousness to reject claims 6, 13, 30, 32, 34, 36-38 and 64 over the Barker '015 patent alone or in view of the Moxey '670 patent and/or the Trevino '797 patent.

Discussion:

Claim 6

Claim 6 depends from claim 12, and since claim 12 defines unobvious patentable subject matter, claim 6 defines unobvious patentable subject matter. Accordingly, claim 6 is in condition for allowance.

Claim 13

Claim 13 depends from claim 12 and further defines the angle and distance device as including a tape measure extender for mechanically extending the tape, thereby allowing a single person to create the template while staying in a single central location. First, claim 13 depends from claim 12, and since claim 12 defines patentable subject matter as discussed above, claim 13 defines patentable subject matter. Second, the Barker '015 patent does not include a tape measure extender. Finally, as to any combination of the Barker '015 patent and the Moxey '670 patent and/or the Trevino '797 patent, this combination has the same deficiencies noted above with regard to claim 12. Accordingly, claim 13 is in condition for allowance.

Claim 30

Claim 30 defines a measuring and layout device including, among other things, a stationary member, a carrier fixedly and rotatably attached to the stationary member and an extendible tape connected to the carrier, the tape being configured to extend from the carrier and including an edge that facilitates reliably marking on the stationary member to form an accurate template, wherein the carrier includes a tape measure extender for mechanically extending the tape, thereby allowing a single person to create the template while staying in a single central location.

The prior art of record does not disclose or suggest the above noted features of claim 30. Specifically, the Barker '015 patent does not disclose a tape measure extender as claimed in claim 30. Accordingly, the Barker '015 patent does not anticipate claim 30.

Furthermore, any combination of the Barker '015 patent and the Moxey '670 patent and/or the Trevino '797 patent would not include all of the claimed features of claim 30. Specifically, neither the Barker '015 patent, the Moxey '670 patent nor the Trevino '797 patent disclose a carrier fixedly and rotatably attached to a stationary member. According to the Office Action, the Moxey '670 patent discloses a layout device that "utilizes means (33) to fasten the device to the stationary member" and "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the angle and distance device disclosed by Barker by adding means for fixedly and rotatably attaching the device to the stationary member, as disclosed by Moxey, in order to fasten the device to the stationary member and thereby obtain a more accurate layout." Office Action mailed January 22, 2003, paragraph 17. However, the Moxey '670 patent does not disclose "means for fixedly and rotatably attaching the device to the stationary member." The Moxey '670 patent discloses a housing 10 having an "embossment 30, which is slotted vertically at two opposite sides, as indicated at 31, to constitute a chuck for a pivot pin 33." Lines 44-48 of column 1 of page 2. During use, the pivot pin 33 is "seated in the surface at the desired point." Lines 2-4 of column 1 of page 3. However, seating the pivot pin 33 in the surface as disclosed by the Moxey '670 patent does not fixedly and rotatably attach the housing 10 to the surface. Therefore, any combination of the Barker '015 patent and the Moxey '670 patent and/or the Trevino '797 patent would not result in a carrier fixedly and rotatably attached to a stationary member. Accordingly, claim 30 is in condition for allowance.

Claims 32 and 38

Claims 32 and 38 depend from claim 30, and since claim 30 defines unobvious patentable subject matter, claims 32 and 38 define unobvious patentable subject matter. Accordingly, claims 32 and 38 are in condition for allowance.

Claim 34

Claim 34 depends from claim 30 and further defines the template as including markings written directly onto the stationary member. First, claim 34 depends from claim 30, and since claim 30 defines patentable subject matter as discussed above, claim 34 defines patentable subject matter. Second, the Barker '015 patent does not include a template as including markings written directly onto the stationary member. The Barker '015 patent does not expressly or inherently disclose markings written directly onto the lower arm 10. Accordingly, the Barker '015 patent does not anticipate claim 34. As to any combination of the Barker '015 patent with the Moxey '670 patent and/or the Trevino '797 patent to rejection claim 34, this combination has the same deficiencies noted above with regard to claim 30. Accordingly, claim 34 is in condition for allowance.

Claim 36

Claim 36 depends from claim 30, and further defines the stationary member as having a circular configuration. First, since claim 30 defines unobvious patentable subject matter, claim 36 defines unobvious patentable subject matter. Second, the Barker '015 patent does not include a stationary member as having a circular configuration. The leg 10 is not circular. Moreover, there is no suggestion or motivation for making the lower leg 10 circular as any such modification would result in a lower leg 10 being smaller than the upper leg 11, thereby not allowing the upper leg 11 full rotation, or would result in a lower leg 10 being bigger than the upper leg 11 and circular, which would not allow full use of the retractable rule 29 and associated functions on the upper leg 11. Accordingly, claim 36 is not anticipated or suggested by the Barker '015 patent. As to any combination of the Barker '015 patent and the Moxey '670 patent and/or the Trevino '797 patent to rejection claim 36, this combination has the same deficiencies noted above with regard to claim 30. Accordingly, claim 36 is in condition for allowance.

Claim 37

Claim 37 depends from claim 30, and further defines the stationary member as having a semi-circular configuration. First, since claim 30 defines unobvious patentable subject matter, claim 37 defines unobvious patentable subject matter. Second, the Barker '015 patent does not include a stationary member as having a semi-circular configuration. The leg 10 is not semi-circular. Moreover, there is no suggestion or motivation for making the lower leg 10 semi-circular as any such modification would result in a lower leg 10 being smaller than the upper leg 11, thereby not allowing the upper leg 11 full rotation, or would result in a lower leg 10 being bigger than the upper leg 11 and semi-circular, which would not allow full use of the retractable rule 29 and associated functions on the upper leg 11. Accordingly, the Barker '015 patent does not include all of the features of claim 37. Therefore, claim 37 is not anticipated or suggested by the Barker '015 patent. As to any combination of the Barker '015 patent and the Moxey '670 patent and/or the Trevino '797 patent to rejection claim 37, this combination has the same deficiencies noted above with regard to claim 30. Accordingly, claim 37 is in condition for allowance.

Claim 64

Claim 64 depends from claim 25 and further defines the method as providing the angle and distance device with a tape extender for mechanically extending the tape and extending the tape with the tape extender. First, since claim 25 defines unobvious patentable subject matter, claim 64 defines unobvious patentable subject matter. Second, the Barker '015 patent does not disclose a tape extender and extending the tape with the tape extender as claimed in claim 64. Accordingly, the Barker '015 patent does not anticipate claim 64. As to any combination of the Barker '015 patent and the Moxey '670 patent and/or the Trevino '797 patent to rejection claim 64, this combination has the same deficiencies noted above with regard to claim 25. Accordingly, claim 64 is in condition for allowance.

Conclusion

Accordingly, claims 6, 13, 30, 32, 34, 36-38 and 64 are allowable over the Barker '015 patent either alone in view of the Moxey '670 patent and/or the Trevino '797 patent, and the Board is requested to reverse the rejection of these claims.

Issue 5: Whether claims 10 and 61 are unpatentable over U.S. Patent No. 3,269,015 to Barker (or the Barker '015 patent in view of U.S. Patent No. 2,349,670 to Moxey and/or U.S. Patent No. 4,344,231 to Martinez)?

Argument:

In order to anticipate the invention as claimed, all elements must be found in a single reference. *Studiengesellschaft Kohle v. Dart Indus.*, 762 F.2d 724 (Fed. Cir. 1984).

Additionally, in order to establish a *prima facie* case of obviousness, three criteria must be met. M.P.E.P. §706.02(j). Firstly, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Fine*, 5 U.S.P.Q.2d 1586 (Fed. Cir. 1988). Secondly, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Thirdly, the prior art reference (or references) must teach or suggest all the claim limitations. *In re Royka*, 180 U.S.P.Q. 550 (C.C.P.A. 1974). The burden is on the Examiner to create a *prima facie* case of obviousness, not on the Applicant to provide reasons for patentability. See *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Applicant submits that neither the Board nor the Examiner has created a *prima facie* case of anticipation or obviousness to reject claims 10 and 61 over the Barker '015 patent alone or in view of the Moxey '670 patent and/or the Martinez '231 patent.

Discussion:

Claim 10

Claim 10 depends from claim 12 and further defines the template as being formed by markings written onto a paper placed on the stationary member. First, since claim 12 defines

unobvious patentable subject matter, claim 10 defines unobvious patentable subject matter. Second, the Barker '015 patent does not disclose a paper placed on the leg 10 or markings written onto paper placed on the leg 10. Accordingly, the Barker '015 patent does not anticipate claim 10. As to any combination of the Barker '015 patent and the Moxey '670 patent and/or the Martinez '231 patent to rejection claim 10, this combination has the same deficiencies noted above with regard to claim 12. Accordingly, claim 10 is in condition for allowance.

Claim 61

Claim 61 depends from claim 25 and further defines the step of forming the accurate template as including writing onto a paper placed on the stationary member. First, since claim 25 defines unobvious patentable subject matter, claim 61 defines unobvious patentable subject matter. Second, the Barker '015 patent does not disclose a paper placed on the leg 10 or writing onto a paper placed on the leg 10. Accordingly, the Barker '015 patent does not anticipate claim 61. As to any combination of the Barker '015 patent and the Moxey '670 patent and/or the Martinez '231 patent to rejection claim 61, this combination has the same deficiencies noted above with regard to claim 25. Accordingly, claim 61 is in condition for allowance.

Conclusion

Accordingly, claims 10 and 61 are allowable over the Barker '015 patent either alone in view of the Moxey '670 patent and/or the Martinez '231 patent, and the Board is requested to reverse the rejection of these claims.

Issue 6: Whether claims 15 and 66 are unpatentable over U.S. Patent No. 3,269,015 to Barker (or the Barker '015 patent in view of U.S. Patent No. 2,349,670 to Moxey and/or French Patent 2,614,982 to Mercier)?

Argument:

In order to anticipate the invention as claimed, all elements must be found in a single reference. *Studiengesellschaft Kohle v. Dart Indus.*, 762 F.2d 724 (Fed. Cir. 1984).

Additionally, in order to establish a *prima facie* case of obviousness, three criteria must be met. M.P.E.P. §706.02(j). Firstly, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Fine*, 5 U.S.P.Q.2d 1586 (Fed. Cir. 1988). Secondly, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Thirdly, the prior art reference (or references) must teach or suggest all the claim limitations. *In re Royka*, 180 U.S.P.Q. 550 (C.C.P.A. 1974). The burden is on the Examiner to create a *prima facie* case of obviousness, not on the Applicant to provide reasons for patentability. See *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Applicant submits that neither the Board nor the Examiner has created a *prima facie* case of anticipation or obviousness to reject claims 15 and 66 over the Barker '015 patent either alone or in view of the Moxey '670 patent and/or the French Patent 2,614,982 to Mercier.

Discussion:

Claim 15

Claim 15 depends from claim 12 and further defines the angle and distance device as having a digital readout for accurately communicating a distance that the tape is extended from the angle and distance device. First, since claim 12 defines unobvious patentable subject matter, claim 15 defines unobvious patentable subject matter. Second, the Barker '015 patent does not disclose a digital readout. Accordingly, the Barker '015 patent does not anticipate claim 15. As to any combination of the Barker '015 patent and the Moxey '670 patent and/or the French Patent 2,614,982 to Mercier to rejection claim 15, this combination has the same deficiencies noted above with regard to claim 12. Accordingly, claim 15 is in condition for allowance.

Claim 66

Claim 66 depends from claim 25 and further defines the method as providing the angle and distance device with a digital readout for accurately communicating a distance that the tape is extended from the angle and distance device. First, since claim 25 defines unobvious patentable subject matter, claim 66 defines unobvious patentable subject matter. Second, the Barker '015 patent does not disclose a digital readout. Accordingly, the Barker '015 patent does not anticipate claim 66. As to any combination of the Barker '015 patent and the Moxey '670 patent and/or the French Patent 2,614,982 to Mercier to rejection claim 66, this combination has the same deficiencies noted above with regard to claim 25. Accordingly, claim 66 is in condition for allowance.

Conclusion

Accordingly, claims 15 and 66 are allowable over the Barker '015 patent either alone or in view of the Moxey '670 patent and/or the French Patent 2,614,982 to Mercier, and the Board is requested to reverse the rejection of these claims.

Issue 7: Whether claim 31 is unpatentable over U.S. Patent No. 3,269,015 to Barker (or the Barker '015 patent in view of U.S. Patent No. 2,349,670 to Moxey, U.S. Patent No. 5,768,797 to Trevino and/or U.S. Patent No. 4,835,870 to Rauch et al)?

Argument:

In order to anticipate the invention as claimed, all elements must be found in a single reference. *Studiengesellschaft Kohle v. Dart Indus.*, 762 F.2d 724 (Fed. Cir. 1984).

Additionally, in order to establish a *prima facie* case of obviousness, three criteria must be met. M.P.E.P. §706.02(j). Firstly, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Fine*, 5 U.S.P.Q.2d 1586 (Fed. Cir. 1988). Secondly, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Thirdly, the prior art reference (or references)

must teach or suggest all the claim limitations. *In re Royka*, 180 U.S.P.Q. 550 (C.C.P.A. 1974). The burden is on the Examiner to create a prima facie case of obviousness, not on the Applicant to provide reasons for patentability. See *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Applicant submits that neither the Board nor the Examiner has created a prima facie case of obviousness to reject claim 31 over the Barker '015 patent either alone or in view of the Moxey '670 patent, the Trevino '797 patent and/or the Rauch et al. '870 patent.

Discussion:

Claim 31 depends from claim 30 and further defines the carrier as including a front leg adjacent a top of the stationary member, with the front leg having guides for the tape and a straight edge for making the template. First, claim 31 depends from claim 30, and since claim 30 defines patentable subject matter as discussed above, claim 31 defines patentable subject matter. Second, the Barker '015 patent does not include a front leg having guides for the tape. Neither the leg 10 nor the leg 11 of the Barker '015 patent comprises a leg having guides for tape. As to any combination of the Barker '015 patent and the Moxey '670 patent, the Trevino '797 patent and/or the Rauch et al. '870 patent to rejection claim 31, this combination has the same deficiencies noted above with regard to claim 30. Accordingly, claim 31 is in condition for allowance.

Accordingly, claim 31 is allowable over the Barker '015 patent alone or in view of the Moxey '670 patent, the Trevino '797 patent and/or the Rauch et al. '870 patent, and the Board is requested to reverse the rejection of this claim.

Issue 8: Whether claim 35 is unpatentable over U.S. Patent No. 3,269,015 to Barker (or the Barker '015 patent in view of U.S. Patent No. 2,349,670 to Moxey, U.S. Patent No. 5,768,797 to Trevino and/or U.S. Patent No. 4,344,231 to Martinez)?

Argument:

In order to anticipate the invention as claimed, all elements must be found in a single reference. *Studiengesellschaft Kohle v. Dart Indus.*, 762 F.2d 724 (Fed. Cir. 1984).

Additionally, in order to establish a *prima facie* case of obviousness, three criteria must be met. M.P.E.P. §706.02(j). Firstly, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Fine*, 5 U.S.P.Q.2d 1586 (Fed. Cir. 1988). Secondly, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Thirdly, the prior art reference (or references) must teach or suggest all the claim limitations. *In re Royka*, 180 U.S.P.Q. 550 (C.C.P.A. 1974). The burden is on the Examiner to create a *prima facie* case of obviousness, not on the Applicant to provide reasons for patentability. See *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Applicant submits that neither the Board nor the Examiner has created a *prima facie* case of anticipation or obviousness to reject claim 35 over the Barker '015 patent in view of the Moxey '670 patent, the Trevino '797 patent and/or the Martinez '231 patent.

Discussion:

Claim 35 depends from claim 30 and further defines the template as including markings written onto a paper placed on the stationary member. First, since claim 30 defines unobvious patentable subject matter, claim 35 defines unobvious patentable subject matter. Second, the Barker '015 patent does not disclose a paper placed on the leg 10 or markings written onto paper placed on the leg 10. Accordingly, the Barker '015 patent does not anticipate claim 35. As to any combination of the Barker '015 patent and the Moxey '670 patent, the Trevino '797 patent and/or the Martinez '231 patent to rejection claim 35, this combination has the same deficiencies noted above with regard to claim 30. Accordingly, claim 35 is in condition for allowance.

Accordingly, claim 35 is allowable over the Barker '015 patent either alone or in view of the Moxey '670 patent, the Trevino '797 patent and/or the Martinez '231 patent, and the Board is requested to reverse the rejection of this claim.

V. Conclusion

Each appealed claim is definite and recites features that are not disclosed by any of the cited references and it would not have been obvious to modify the cited references to include the recited features of the appealed claims. The references upon which the Board and the Examiner relies in his rejections of the finally rejected claims do not disclose or suggest a carrier or an angle and distance device fixedly and rotatably connected to a stationary member or a method of measuring and layout including marking or recording both angle or direction and distance information. Applicant's invention resolves problems and inconveniences experienced in the prior art, and therefore represents a significant advancement in the art. Applicant earnestly requests that the Examiner's final rejection of 2-7, 9-15, 25, 30-32, 34-38, 54-56, 58, 60-67 and 69, inclusive, be reversed, and that the subject application be passed to issuance forthwith.

Respectfully submitted,

JOSEPH D. REVNELL

By: Price, Heneveld, Cooper,
DeWitt & Litton

Date

4/15/05

Marcus P. Dolce

Registration No. 46 073

695 Kenmoor, S.E.

Post Office Box 2567

Grand Rapids, Michigan 49501

(616) 949-9610

MPD/msj